



Paper No. 6

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OFFICE OF PETITIONS

In re Application of :
Shi, Tay, Flynn, Tan, and Fulton : DECISION REFUSING STATUS
Application No. 10/014,387 : UNDER 37 CFR 1.47(a)
Filed: 11 December, 2001 :
Attorney Docket No. GWS/18240CIP :

This is a decision in response to the petition under 37 CFR
1.47(a) filed on 12 July, 2002.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of
this decision to reply, correcting the below-noted deficiencies.
Any reply should be entitled "Request for Reconsideration of
Petition Under 37 CFR 1.47(a)," and should only address the
deficiencies noted below, except that the reply may include an
oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.

Extensions of time may be obtained in accordance with 37 CFR
1.136(a).

The above-identified application was filed on 11 December, 2001,
without an executed oath or declaration. Accordingly, on 12
February, 2002, Initial Patent Examination Division mailed a
Notice to File Missing Parts of Nonprovisional Application,
requiring an executed oath or declaration and a surcharge for its
late filing. In response, on 12 July, 2002, petitioners
submitted a declaration naming Xu Shi, Beng Kang Tay, David Ian
Flynn, Hong Siang Tan, and Michael Fulton as joint inventors and
signed by all of the joint inventors except Fulton. The
declaration was also signed by joint inventor Tay on behalf of
non-signing joint inventor Fulton. The present petition,

surcharge, and authorization to charge a three (3) month extension of time, were also filed.

Petitioners state that Fulton has moved and is believed to be living in the United States and cannot now be located.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

The petition lacks items (1), (2), and (5).

In regards to item (1), petitioners have not shown that diligent efforts were made to locate the non-signing inventor.¹ At a minimum, petitioners must send or give a copy of the application papers (specification, including the claims, drawings, if any, and the declaration) to the non-signing inventor at the inventor's last known address. Petitioners may show diligent efforts to locate the non-signing inventor by providing a copy of an envelope showing that a letter sent to the last known address of the non-signing inventor was returned as undeliverable by the post office. Details of the efforts made to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Additionally, if Fulton no longer lives at the last known address, petitioners may show diligent efforts (e.g., by use of Internet or other database searches) to determine a current address for the non-signing inventor. If a more recent address is discovered, petitioners should send or give a copy of the application papers to the inventor at that address.

If the envelope sent to the non-signing inventor at the last

¹MPEP 409.03(d).

known address is returned as undeliverable by the post office, petitioners should provide a copy of the envelope showing that the application was returned as undeliverable with any renewed petition. If the inventor refuses in writing to sign, a copy of that written refusal should be provided with any renewed petition. If the inventor refuses orally, petitioners should submit details of the refusal in an affidavit or declaration of facts by a person having first-hand knowledge of the refusal.

If repeated attempts to contact the non-signing inventor are unsuccessful, petitioners will have shown that despite diligent efforts, the inventor could not be reached.

In regards to item (2) the declaration submitted with the present petition is not acceptable because only one of the joint inventors (Tay) has signed on behalf of non-signing inventor Fulton. A declaration is acceptable if all of the signing inventors signed in their respective signature blocks and the signature block of the non-signing inventor is left blank or all the signing inventors sign a statement saying that they are signing on behalf of the non-signing inventor. A declaration is not acceptable if there are two or more signing inventors and only one of the signing inventors signed on behalf of the non-signing inventor. A new oath or declaration in compliance with 37 CFR 1.63 and 1.67, signed by all of the signing inventors on behalf of themselves and the non-signing inventor, must be submitted with any renewed petition.

In regards to item (5), if a more recent last known address is discovered for the non-signing inventor, that address must be provided with any renewed petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.

A handwritten signature in cursive script, appearing to read "D Wood".

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy